UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,929	09/15/2003	Anthony J. Baerlocher	0112300-1542	2727

29159 7590 07/23/2007

BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER	
BANTA, TRAVIS R	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/23/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No.	Applicant(s)	
	10/662,929	BAERLOCHER, ANTHONY J.	
	Examiner	Art Unit	
	Travis R. Banta	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-4,8 and 26-47* is/are allowed.

6)☒ Claim(s) *5-7 and 9-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5 and 9 -15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,634,943. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 17 of US 6,634,943 teaches a processor in a gaming device, a plurality of bonus rounds equivalent to a plurality of games – at least a first and second game, a plurality of selections in a game, a plurality of advances in a game, a plurality of picks provided to a player, an input device inherently equivalent to "a processor operable to enable a player to pick at least one of the selections" – if a player can make

a selection, inherently there must be an input device, an award provided to a player based on accumulated values of the advances.

Claim 17 fails to specifically disclose masked selections, different values for advances and advances associated with at least one selection in each of the games. However, one of ordinary skill in the art would recognize that it is 1. obvious to mask selections in a pick game, 2. to associate different values with the selections, and 3. to associate the advances with at least one selection in each of the games.

1. The skilled artisan would recognize a player's draw to a picking game is that the player can win based purely on chance instead of skill. Thus, all players are allowed the same probability of winning. If selections were revealed to players before the player picked, the player would only select those picks that would result in a player winning. A player would never select a losing pick. Thus, all players would have 100% ability to win. Chance would be removed from the game. The skilled artisan would find this wholly unacceptable because this type of phenomenon is not commercially viable. It would therefore be obvious to the ordinarily skilled artisan at the time of the invention to mask the selections of the game such that players played the game purely on chance.

2. The skilled artisan would recognize that supplying various degrees of awards to a player is well known in the art. Varying award degrees is a way to provide a player with a winning outcome while not providing the player the maximum winning outcome. The ordinarily skilled artisan would recognize at the time of the invention that it would be obvious to provide different award amounts for selection to maintain a player's interest

by allowing the player a good possibility to win a lesser amount so the player would not be frustrated and quit playing the game.

3. The skilled artisan would recognize that associating advances with the selections in the game is also well known in the art. Indeed, it would be difficult to not associate selections with advancements in the game. In a given set of selections, a player is provided a certain number of picks. When the player makes a first pick from the set of selections, the game is advanced because there is one less selection to pick in the subsequent round. It would therefore be obvious to one of ordinary skill in the art to associate advances with a selection in each of the games.

Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, and 18 of U.S. Patent No. 6,634,943. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 17 discloses a plurality of independent bonus rounds each having at least a different function and an award adapted to be provided to the player based on an accumulated number of credits based on player opportunities – equivalent to "picks". Claim 17 in combination with claim 18 teaches a plurality of advancements associated with each of the player opportunities used by a player in each game and advancements are accumulated in the game. Further as a player accumulates a predetermined number of advancements, credit values are associated with each of the player opportunities in the game.

Claims 17 and 18 fail to specifically disclose independent games. However, one of ordinary skill in the art would recognize that independent bonus rounds are similar to independent games within a game though not precisely equivalent. It is well known in the art that successful bonus games can be made into stand-alone games. It would therefore be obvious to one of ordinary skill in the art to use independent games instead of independent bonus rounds in the gaming device of claim 17.

Claims 7 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, and 18 of U.S. Patent No. 6,634,943. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 17 discloses a plurality of independent bonus rounds each having at least a different function and an award adapted to be provided to the player based on an accumulated number of credits based on player opportunities – equivalent to "picks". Claim 17 in combination with claim 18 teaches a plurality of advancements associated with each of the player opportunities used by a player in each game and advancements are accumulated in the game. Further as a player accumulates a predetermined number of advancements, credit values are associated with each of the player opportunities in the game.

Claims 17 and 18 fail to specifically disclose a game including a plurality of independent games. However, one of ordinary skill in the art would recognize that a bonus games are well known in the art to be subgames within a main game. One of

ordinary skill in the art at the time of the invention would find it obvious to include a base game to trigger a bonus round in a bonus game.

Claims 17 and 18 fail to specifically disclose independent games. However, one of ordinary skill in the art would recognize that independent bonus rounds are similar to independent games within a game though not precisely equivalent. It is well known in the art that successful bonus games can be made into stand-alone games. It would therefore be obvious to one of ordinary skill in the art to use independent games instead of independent bonus rounds in the gaming device of claim 17.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites "a second outcome different from said first outcome resulting from a second component of said first game." Later in the claim it recites "wherein said second outcome is determined by said first outcome." It is unclear to the Examiner how the second outcome can be determined by both the first outcome, and the second component of a first game when the second outcome is described in the claim to be "different from said first outcome". The second outcome cannot be determined by both

the second component of a first game, and the outcome of the first game at the same time because the first component results in the first outcome. The second outcome is different from the first outcome but both rely on the first component to provide the outcome. As such, this claim is unclear.

Claims 23-25 are rejected as these claims are dependent on a rejected base claim.

The rejections made in the previous action under 35 U.S.C. 102 have been maintained as the Examiner is relying on the previous interpretation of claim 22. The Examiner encourages the Applicant to contact the Examiner to discuss overcoming the rejection made herein.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Vancura (US 6,059,289).

Regarding claim 22, Vancura ('289) discloses a primary slot machine determining a result and a second outcome different from the first depending on the result of the secondary slot system. The secondary game system has additional bonus games that are initiated by achieving a second outcome on the secondary system. The outcome of the bonus round is dependent on the primary slot machine determining whether a bonus

round will be played. A display device is provided for a player. (see column 3 lines 1-11).

Regarding claim 23, Vancura ('289) discloses the primary game includes a first selection game having a predetermined number of picks: The selection game has numeric symbols (see figure 4) associated with the selections and the outcome of the selection game is based on the associated numeric symbols. Whether the accumulation game begins is dependant on the outcome of the numeric symbols from the choice selection game (see also column 14 lines 42-67).

Regarding claim 24, Vancura ('289) discloses the secondary game has an advancement game having 5 different positions. The numeric symbols associated with the selection picked by the player in the bonus game determine the degree of advancement of the player in the game. The initiation of the second game is based on advancing the player a number of positions as determined by the first game in allowing the bonus round (see column 15 lines 1-36).

Regarding claim 25, Vancura ('289) discloses the award outcome provided to the player is based on the numeric symbols associated with the player and as accumulated by selection in the accumulation game (see column 15 lines 1-36).

Response to Arguments

Regarding claim 22, the Applicant has argued "...Vancura does not disclose a first outcome of a first component of a game determining a second outcome resulting from a second component of the first game." The Examiner respectfully disagrees.

In addition to the comments made under the 35 U.S.C. 112 rejection above, the Examiner wishes to point out that the previous interpretation of these claims is being used in this action. The Examiner understands the first outcome of a first component of a game in Vancura to be a non-bonus gaming event such as a slot machine game where no bonus event is triggered. The first outcome of the game is either a win or a loss. The second outcome is a bonus-triggering event. This is also a component of a first game. By the broadest reasonable interpretation, the game outcome in the first component such as a win or a loss determines whether a bonus round will even occur. Therefore, a second outcome is determined to occur. The result is unspecified, but a second outcome is determined none the less. Thus, Vancura does disclose a first outcome of a first component of a game determining a second outcome resulting from a second component of the first game.

Allowable Subject Matter

Claims 1-4, 8, and 26-47 are allowed as amended.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis R. Banta whose telephone number is (571) 272-1615. The examiner can normally be reached on Monday-Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TB

Ronald Laneau

RONALD LANEAU
PRIMARY EXAMINER

7/17/07